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Paper No. 11
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bio Genesis USA, Inc.

Serial No. 75/513,763

Katherine G. Schmidt and Donald L. Dennison of Dennison, Meserole, Scheiner & Schultz for applicant.

Darlene D. Bullock, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Quinn, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Bio Genesis USA, Inc. to register the mark BIO GENETIQUES for "health spas featuring wellness services, namely, nutrition plan counseling and weigh-ins, weight reduction diet planning and supervision, massage and sauna."¹

¹ Application Serial No. 75/513,763, filed July 6, 1998, alleging a date of first use anywhere of March 1996, and a date of first use in commerce of October 23, 1996.

Registration has been refused by the Trademark Examining Attorney under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark BIO GENETIC HEALTH GROUP ("HEALTH GROUP" disclaimed) for "nutritional supplements and vitamins"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. Applicant filed a request for an oral hearing, but later withdrew the request.

Applicant states that its mark comprises a French term which is translated into English as "biogenetics." Applicant goes on to point to a dictionary which defines "biogenetic" as "relating to or produced by biogenesis," which term is defined as "the development of life from preexisting life."³ Applicant goes on to contend that registrant's mark is merely descriptive and, therefore, essentially that it is entitled to a narrow scope of

² Registration No. 2,128,648, issued January 13, 1998.

³ While applicant failed to cite the relevant dictionary or submit a copy of the listing therein, the definitions comport with ones found by the Board in *Webster's Third New International Dictionary* (1993), evidence of which we may take judicial notice.

protection. Applicant also relies on the differences between the involved goods and services, contending that its services are provided exclusively through its spa outlet whereas nutritional supplements and vitamins are customarily sold in health food, vitamin, drug and grocery stores. Applicant also asserts that consumers of applicant's services and registrant's goods may be expected "to exercise special care" in choosing and purchasing such services and goods.

The Examining Attorney maintains that applicant's mark is the foreign equivalent of the dominant portion of the cited mark. The Examining Attorney also states that supplements are often used in weight reduction programs, a fact shown by the specimens of record. In connection with her contention that the good and services are related, the Examining Attorney submitted third-party registrations showing that goods and services of the types involved herein are marketed by a single entity under a single mark.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the

similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the marks. Although we stress that we have considered the marks in their entirety, including the disclaimed portion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." *Id.* at 751. In this connection, "BIO GENETIC" is clearly the dominant part of registrant's mark, with the disclaimed terms "HEALTH GROUP" being relegated to a subordinate role because they have no source-identifying function. The term "BIO GENETIC" alone would likely be used in calling for registrant's goods. Applicant readily recognizes that the French term "biogenetique" is translated into English as "biogenetic" and that, therefore, the terms are foreign equivalents. See, e.g.: In *re Hub Distributing, Inc.*, 218

USPQ 284 (TTAB 1983). As such, applicant's mark is identical in meaning to the dominant portion of registrant's mark. Further, unlike some situations with foreign and English equivalent words, applicant's mark BIOGENETIQUES, although a French term, sounds similar to "biogenetics" and the terms look alike. Even consumers not familiar with the French language likely would readily translate applicant's mark into "biogenetics". With respect to appearance, we especially note that both marks employ a separate "BIO" portion as opposed to the normal presentation "biogenetic" as a unitary word. We view this similar construction as enhancing the likelihood of confusion, given the normal fallibility of human memory over time and the fact that consumers retain a general rather than a specific impression of trademarks/service marks encountered in the marketplace. In sum, the similarities between the marks BIO GENETIQUES and BIO GENETIC HEALTH GROUP, when considered in their entireties, outweigh the dissimilarities.

Also with respect to the marks, we note that the record is devoid of evidence of any third-party uses or registrations of the same or similar marks in the fields of weight reduction, supplements and vitamins. And, although the marks may be viewed as somewhat suggestive given the

meaning of "biogenetic", the same suggestion is conveyed by the marks.⁴

We next turn to compare applicant's nutrition plan counseling and weigh-ins, weight reduction diet planning and supervision services with registrant's nutritional supplements and vitamins. With respect to the goods and services, it is not necessary that they be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same person under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). In the present case, we find the goods and services to be sufficiently related that, when marketed under similar marks, consumers are likely to be confused. As identified, registrant's goods are presumed to encompass

⁴ Contrary to applicant's arguments, we do not view registrant's mark as merely descriptive. The mark registered on the Principal Register and is an inherently distinctive mark.

all types of nutritional supplements and vitamins, including those that may be used in weight loss programs. Applicant's services and registrant's goods also are presumed to be purchased by the same classes of purchasers, that is, ordinary consumers. See: Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). There is no evidence to suggest that these consumers would be expected, in applicant's words, "to exercise special care" in purchasing the goods and services.

In finding that applicant's nutrition plan counseling and weight reduction diet planning and supervision services are related to registrant's nutritional supplements and vitamins, we have considered the five third-party registrations which the Examining Attorney has submitted. The registrations show marks which are registered for both types of goods and services as those involved here. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods and services listed therein are of a kind which may emanate

from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988). Indeed, this view is buttressed by applicant's informational brochures which were submitted as specimens. The brochures highlight applicant's weight loss program and read, in pertinent part, as follows: "Bio Genetiques has combined this 'state of the art' [medical diagnostic] equipment with the amazing thermogenic **supplements** for the first time in a clinical setting...You can enjoy your life-style and still dine out with the help of **supplements** to curb your appetite, increase your energy and raise the level of calorie burning." [emphasis added]

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

We conclude that consumers familiar with registrant's nutritional supplements and vitamins sold under its mark BIO GENETIC HEALTH GROUP would be likely to believe, upon encountering applicant's mark BIO GENETIQUES for nutrition

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plan counseling and weigh-ins, and weight reduction diet planning and supervision services, that the goods and services originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.

T. J. Quinn

C. E. Walters

T. E. Holtzman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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